

**In the Drawings:**

Please amend FIGs. 1A & 1B to included a --Prior Art-- designation as shown in the replacement sheet included herewith.

## **REMARKS**

Claims 18-28 and 39-40 have been amended. Claims 1-40 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

### **Finality of the Action:**

The Examiner improperly made the present Office Action a Final Action. The present Action includes new grounds of rejection under 35 U.S.C. §§ 101 and 112. Neither of these new rejections were necessitated by amendment. The Examiner also changed the basis for the rejection of claim 15. Therefore, according to MPEP 706.07(a), the present action cannot be made Final. Applicants request withdrawal of the Finality of the present Action pursuant to MPEP 706.07(a) and 706.07(d).

### **Drawings Objection:**

The Examiner states that FIGs. 1-2 should be designated by a legend such as --Prior Art--. A replacement sheet is included herewith in which a --Prior Art-- designation has been added for FIGs. 1A & 1B. No change has been made for FIG. 2 since FIG. 2 does not illustrate only that which is known from the prior art. Withdrawal of the objection to the drawings is respectfully requested.

### **Section 101 Rejection:**

The Examiner rejected claims 18-28 and 38-40 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants traverse this rejection. In regard to claims 18-28, Applicants assert that an “article of manufacture” is statutory subject matter. In fact, 35 U.S.C. § 101 specifically refers to a “manufacture” as patentable subject matter. There is no basis in the statute, case law or MPEP to support the Examiner’s assertion that reciting an “article of manufacture” in a claim means that the claim is nonstatutory. Likewise, the Examiner has cited no authority for the rejection of

claims 38-40. Accordingly, the rejection is traversed. For reasons of expediency, claims 18-28 and 38-40 have been amended to recite a “tangible, computer-readable medium”; however, Applicants do not view this as a change in the scope of the claim or as an amendment made for a reason of patentability. Withdrawal of the § 101 rejection is respectfully requested.

### **Provisional Double Patenting Rejection:**

The Examiner *provisionally* rejected claims 1-40 under the judiciary created doctrine of obviousness-type double patenting as being unpatentable over claims 1-61, 1-203 and 1-71 of co-pending Application Nos. 10/055,649, 10/055,641 and 10/055,741 respectively. Applicants traverse this rejection on the grounds that the Examiner has not stated a proper *prima facie* rejection. The only support given by the Examiner for the rejection is “because the context of the claimed invention is the same as the context of the cited claims of the U.S. patent applications.” However, simply being in the same context (whatever that means) is not a proper reason for holding the claims of the present application obvious from the claims of the listed applications. According to MPEP 804.II.B.1, “the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection.” This section of the MPEP also states that the same “factual inquiries ... that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are employed when making an obviousness-type double patenting analysis.” MPEP 804.II.B.1 also states that the Examiner should list the differences between **each** rejected claim and the claims of the other patent/application, and for **each** difference the Examiner should give the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim is an obvious variation of the invention defined in a claim of the other patent/application. Simply stating that the claims are “in the same context” is not a valid reason why a person of ordinary skill in the art would conclude that the invention defined in each claim is an obvious variation of the invention defined in a claim of the other patent/application. Nor has the Examiner specifically addressed **each difference of each claim** of the present application compared to the claims of the other applications.

Instead, the Examiner improperly lumped all the claims together and did not address each specific difference. The Examiner clearly has not met the requirements stated in MPEP 804.II.B.1 to establish a *prima facie* obviousness-type double patenting rejection. Accordingly, Applicants respectfully request removal of the double patenting rejection of claims 1-40.

**Section 112, Second Paragraph, Rejection:**

The Examiner rejected claims 7, 19-20 and 22 under 35 U.S.C. § 112, second paragraph, as indefinite. Applicants traverse this rejection. One of ordinary skill in the art would have no trouble in ascertaining the meaning of the original claims. For reasons of expediency, claims 7, 19 and 22 have been amended to remove the perceived antecedent basis issue; however, Applicants do not view this as a change in the scope of the claim or as an amendment made for a reason of patentability. Withdrawal of the § 112, second paragraph, rejection is respectfully requested.

**Section 103(a) Rejection:**

The Examiner rejected claims 1-6, 8-18, 21 and 23-40 under 35 U.S.C. § 103(a) as being unpatentable over Teodosiu et al. (U.S. Publication 2002/0062375) (hereinafter “Teodosiu”) and Badovintz et al. (U.S. Patent 5,896,503) (hereinafter “Badovintz”). Applicants respectfully traverse this rejection for at least the following reasons.

**First, the rejection is improper because the Examiner has not shown that Teodosiu qualifies as a prior art reference.** More specifically, Teodosiu is a published U.S. patent application that was filed on Sep. 13, 2001, after Applicants’ priority date of Jan. 22, 2001. Teodosiu does claim the benefit of two provisional applications both filed Nov. 22, 2000. However, the Nov. 22, 2000 filing date can only be used as Teodosiu’s 35 U.S.C. § 103(a) prior art date for the subject matter that is common to both the published application and the provisional application. Since it is common practice for a later filed utility application to include more or different subject matter than its earlier

provisional application, it is unclear whether the material in Teodosiu relied upon by the Examiner was actually present in one of Teodosiu's provisional applications. **In fact, examination of Teodosiu's two provisional applications shows that they vary greatly from Teodosiu's published utility application.** It is not apparent that the subject matter on which the Examiner is relying on to reject Applicants' claims is also present in one of Teodosiu's provisional applications. Unless the Examiner can make this showing, the rejection is improper. *See, In re Wertheim*, 209 USPQ 554 (CCPA 1981).

**The Examiner failed to address the above argument in the present Action.**

Specifically, the Examiner has not shown that every portion of Teodosiu relied upon by the Examiner to reject Applicants' claims is found in one of Teodosiu's provisional applications. For example, in the rejection of claims 1-6, 8-18, 21 and 23-40, the Examiner relies on the following paragraphs and figures of Teodosiu: [0016], [0030 - 0037], [0045], [0053], [0073], [0074], [0077], [0094 - 0097] and FIGs. 1 and 3. None of these paragraphs are found in either of Teodosiu's provisional applications and FIGs. 1 and 3 of Teodosiu are drawn and labeled differently in provisional application 60/252,658. The Nov. 22, 2000 filing date can only be used as Teodosiu's 35 U.S.C. § 103(a) prior art date for the subject matter that is common to both the published application and the provisional application. *See, In re Wertheim*, 209 USPQ 554 (CCPA 1981). **Since the portions of Teodosiu relied upon by the Examiner to reject the claims are not common to both Teodosiu's published application and one of Teodosiu's provisional applications, the rejection is improper.**

**Moreover, Teodosiu's published application is not entitled to the Nov. 22, 2000 date as a section 103(a) prior art date unless at least one claim of Teodosiu's published application is supported (under 35 U.S.C. § 112) in the provisional application.** Under 35 U.S.C. 119(e)(1), a published utility application is not entitled to its provisional application's filing date as a prior art date unless at least one claim of the published utility application is supported (per 35 U.S.C. § 112) in the provisional application. Since both of Teodosiu's provisional applications are much shorter informal papers as compared to Teodosiu's utility application, it is not at all clear that either one of

Teodosiu's provisional applications provide full 35 U.S.C. § 112 support for any of the claims of Teodosiu's published utility application. The rejection is improper unless the Examiner can show that Teodosiu's published application has the necessary claim support in the provisional application to be entitled to the provisional application's filing date as its § 103(a) prior art date. *See also* M.P.E.P. § 2136.03(IV).

In response to this argument, the Examiner states that pages 3-4 of Teodosiu's provisional application no. 60/252,658 teach the limitations of claim 1 of Teodosiu's published application. However, a careful review of pages 3-4 of Teodosiu's provisional application no. 60/252,658 fails to reveal that this portion of Teodosiu's provisional application satisfies the written description and enablement requirements of 35 U.S.C. § 112 for claim 1 of Teodosiu's published application. Claim 1 of Teodosiu's published application recites:

1. A method comprising:
  - receiving a peer resource request at a resource naming service (RNS) server, said peer resource request being received from a peer platform through a networking environment;
  - generating a peer resource response based on the peer resource request; and
  - returning the peer resource response to the peer platform through the networking environment, said peer resource response to enable the peer platform to access a peer resource corresponding to the peer resource request within the networking environment.

Pages 3-4 of Teodosiu's provisional application no. 60/252,658 do not describe the RNS server "receiving a peer resource request ... from a peer platform through a networking environment". Nor do pages 3-4 of Teodosiu's provisional application no. 60/252,658 describe "generating a peer resource response based on the peer resource request". Nor do pages 3-4 of Teodosiu's provisional application no. 60/252,658 describe "returning the peer resource response to the peer platform through the networking environment, said peer resource response to enable the peer platform to access a peer resource corresponding to the peer resource request within the networking environment." **Since the Examiner has not shown that Teodosiu's provisional application satisfies the written description and enablement requirements for any claim of Teodosiu's published application, the rejection is improper. *See*, M.P.E.P. § 2136.03(IV).**

Applicants also note that public PAIR shows that claim 1 of Teodosiu's application has been amended to include other limitations that are not found in Teodosiu's provisional applications.

The Examiner has the burden of proof to produce the factual basis for the rejection. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). **Since the Examiner has not proven that both of the above requirements have been met for Teodosiu's teachings to qualify as prior art, the Examiner has not met this burden of proof and the rejection is improper.**

Furthermore, in regard to claim 1, the Examiner admits that Teodosiu "fails to teach at least a subset of the peer nodes are configured to participate in a peer membership protocol for joining or forming a peer group with other peer nodes." The Examiner goes on to state that it would have been obvious to "combine Teodosiu's peer computing system with Badovinatz's management of membership of a domain of processors, for the advantage of maintaining high service availability by recovering the main source of service as quickly as possible." However, Applicants remind the Examiner that "to support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references..." *Ex Parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int'f 1985).

Applicants note that Badovinatz does not mention peer-to-peer networking at all. Since the Examiner admits that Teodosiu does not teach the subject functionality, it is incumbent upon the Examiner to "present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." However, Badovinatz only describes a mechanism for managing membership of a domain of processors in a distributed computing

environment. Nowhere does Badovinatx “expressly or impliedly” suggest that this mechanism should be used in a peer computing system to enable peer nodes to participate in a peer membership protocol for joining or forming a peer group with other peer nodes. The Examiner states that it would have been obvious to combine Teodosiu’s peer computing system with Badovinatx’s management of membership of a domain of processors for the advantage of “maintaining high service availability by recovering the main source of service as quickly as possible.” However, nowhere does Teodosiu or Badovinatx “expressly or impliedly” suggest that “maintaining high service availability by recovering the main source of service as quickly as possible” would apply in a peer computing system. In fact, by their very nature peer computing systems typically seek to avoid a “main source of service”. **Thus, Badovinatx actually teaches away from a peer-to-peer system.**

Applicants respectfully assert that “maintaining high service availability by recovering the main source of service as quickly as possible” is not commensurate with the suggested combination of Teodosiu’s “peer computing system” and Badovinatx’s mechanism. Further, as Badovinatx teaches a mechanism that provides the cited advantage (for processors in a distributed computing environment), the Examiner provides no motivation to combine Teodosiu’s “peer computing system” and Badovinatx’s mechanism to obtain the cited advantage. In other words, the Examiner has only given a reason to use Badovinatx’s system, not a reason to modify Teodosiu’s system. Applicants therefore respectfully assert that the Examiner’s “line of reasoning” that combining Teodosiu’s “peer computing system” with Badovinatx’s mechanism “for the advantage of maintaining high service availability by recovering the main source of service as quickly as possible” is not a convincing line of reasoning as to why the claimed invention would have been obvious in light of the teachings of the references.

In regard to this argument, the Examiner states on p. 9 of the present Action that the distributed computing environment of Badovinatx “inherently supports peer-to-peer computing.” The Examiner is clearly incorrect. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to



reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Badovinat’s system does not necessarily support peer-to-peer computing. In fact, as shown above, Badovinat’s reliance on a “main source of service” specifically teaches away from a peer-to-peer system.

On p. 9 of the present Action the Examiner also states that it would be obvious to combine the references “because it would manage membership of a domain of computers of a distributed computing environment”, citing col. 1, lines 5-8, of Badovinat. However, this is simply a reason to use Badovinat’s system, not a reason to modify Teodosiu. Furthermore, Badovinat’s system is specifically not a peer-to-peer system. One of ordinary skill in the art would have no reason to apply the teaching of Badovinat to Teodosiu.

Thus, for at least the reasons presented above, the rejection of claim 1 is not supported by the cited prior art and removal thereof is respectfully requested. Similar remarks as those above regarding claim 1 also apply to claims 5, 12, 13 and 18.

Regarding claim 6, contrary to the Examiner’s assertion, Teodosiu fails to disclose a peer computing system wherein one or more peer nodes in said peer group are configured to participate in a peer resolver protocol configured for use in sending search queries from one peer group member to another peer group member. Examiner cites Teodosiu, paragraph [0094], which in part states:

...external network traffic 125 is received by gate server 120. Gate server 120 can resolve resource addresses and instruct the senders on how to query the resource locator, or gate server 120 can resolve resource addresses and access the resources on behalf of the senders.

Note also that in Teodosiu, paragraph [0039], the functionality of gate server 120 of FIG. 1 is described:

[0039] For a client device outside realm 150, external network traffic 125 is directed to realm 150 through gate server 120. Gate server 120, possibly in cooperation with registrar 110 and one or more RNS servers 130, determines one or more peer locations 140 within realm 150 where the resource is expected to be available, in accordance to the resource location process described above. Depending on whether the client device is compatible with the peer(s) hosting the resource, gate server 120 may simply respond with the location(s) and allow the client device to directly access the resource on its own. If the client device is not compatible, gate server 120 may take any number of actions, such as accessing the resource on behalf of the client device and responding as if the gate server were the resource.

Note that, in Figure 1 of Teodosiu, realm 150 is where the peers 140 disclosed by Teodosiu reside, and that the client devices are described as being outside realm 150. In paragraph [0094] and elsewhere, Teodosiu discloses a gate server that can receive external network traffic from client devices external to the “realm”, resolve resource addresses, and either instruct the external senders (client devices) on how to query the resource locator, or alternatively access the resources on behalf of the senders. As Teodosiu teaches in [0094] and elsewhere that the gate servers resolve resource addresses for external network traffic from external senders (client devices), it is clear that the gate server disclosed by Teodosiu is not analogous to a peer resolver protocol configured for use in sending search queries from one peer group member to another peer group member.

On p. 10 of the present Action, the Examiner simply refers to the gate server and paragraphs [0094 - 0097] of Teodosiu. However, as shown above, this portion of Teodosiu fails to teach or suggest the limitations of claim 6. The Examiner did not address the specific arguments made above. **Furthermore, paragraphs [0094 - 0097] of Teodosiu are not found in Teodosiu’s provisional application and thus cannot be used to reject Applicants’ claims.**

Thus, for at least the reasons presented above, the rejection of claim 6 is not supported by the cited prior art and removal thereof is respectfully requested. Similar remarks as those above regarding claim 6 also apply to claims 14 and 21.

Regarding claim 8, contrary to the Examiner's assertion, Teodosiu fails to disclose a peer computing system, wherein one or more peer nodes in said peer group are configured to participate in an endpoint routing protocol for enabling the peer nodes to request peer routing information to reach other peer nodes. Teodosiu clearly does not teach or suggest that, to locate resources, peers have to know peer routing information. Instead, Teodosiu, in paragraphs [0036] and [0037], discloses in reference to FIG. 1 a Resource Naming Service (RNS) server that receives a request for a resource from a peer, attempts to determine a location or locations for the resource and, if a location or locations for the resource are found, returns the location(s) to the requesting peer, which then is responsible for accessing the resource at (one of the) returned location(s). Teodosiu does not teach in this citation or elsewhere that the RNS server enables the peer nodes to request peer routing information to reach other peer nodes. Instead, Teodosiu teaches that the RNS server returns location(s) for a requested resource to the requesting peer, which is then responsible for accessing the resource at the provided location(s). Moreover, to locate a resource, Teodosiu teaches that a peer sends a request to an RNS server (which is not a peer, and thus sending a message to the RNS server would not require knowledge of "peer routing information"), which returns a location or locations for the resource.

On p. 10 of the present Action, the Examiner simply refers to paragraphs [0033 - 0037] of Teodosiu. However, as shown above, this portion of Teodosiu fails to teach or suggest the limitations of claim 8. The Examiner did not address the specific arguments made above. The Examiner also states that Teodosiu inherently teaches peer nodes can request peer routing information to locate resources. The Examiner is incorrect. To rely upon a theory of inherency, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Nothing in Teodosiu requires that peer nodes necessarily request peer routing information, let alone one or more peer nodes in said peer group being configured to

participate in an endpoint routing protocol for enabling the peer nodes to request peer routing information to reach other peer nodes. **Furthermore, paragraphs [0033 - 0037] of Teodosiu are not found in Teodosiu's provisional application and thus cannot be used to reject Applicants' claims.**

Thus, for at least the reasons presented above, the rejection of claim 8 is not supported by the cited prior art and removal thereof is respectfully requested. Similar remarks as those above regarding claim 8 also apply to claims 16 and 23.

Regarding claim 9, contrary to the Examiner's assertion, Teodosiu fails to disclose a peer computing system, wherein at least a subset of the peer nodes are configured to participate in a peer information protocol for enabling the peer nodes to learn about other peer nodes' capabilities and status. Applicant fails to see where, in the cited paragraphs or elsewhere, Teodosiu teaches or suggests that an RNS server enables peer nodes to learn about other peer nodes' capabilities and status.

On p. 10 of the present Action, the Examiner simply refers to paragraphs [0031 - 0032] and [0073] of Teodosiu. However, these portions of Teodosiu do not teach anything about participating in a peer information protocol for enabling the peer nodes to learn about other peer nodes' capabilities and status. **Furthermore, paragraphs [0031 - 0032] and [0073] of Teodosiu are not found in Teodosiu's provisional application and thus cannot be used to reject Applicants' claims.**

Thus, for at least the reasons presented above, the rejection of claim 9 is not supported by the cited prior art and removal thereof is respectfully requested. Similar remarks as those above regarding claim 9 also apply to claims 17 and 24.

In regard to claim 15, the cited art does not teach or suggest means for member peer nodes in said peer group to bind to a pipe endpoint. In regard to claim 15, the Examiner only refers to the rejection of claims 1-6 and 8-11. However, none of claims 1-6 and 8-11 recite means for member peer nodes in said peer group to bind to a pipe

endpoint. **Therefore, the Examiner has failed to even attempt to state a *prima facie* rejection for claim 15.** Furthermore, in the Office Action of April 4, 2005, the Examiner acknowledged that Teodosiu does not teach binding to a pipe endpoint. Thus, the rejection of claim 15 is clearly improper.

**Furthermore, the Examiner has failed to attempt to state a *prima facie* rejection for claims 12-14, 16-18, 21 and 23-40.** The Examiner only states that these claims have similar limitations to claims 1-6 and 8-11 and are being rejected under the same rationale as claims 1-6 and 8-11. **However, claims 12-14, 16-18, 21 and 23-40 have a different scope than claims 1-6 and 8-11. Since the Examiner has failed to address the differences between the claims, the Examiner's rejection of claims 12-14, 16-18, 21 and 23-40 is improper.** The following is an example of such differences that the Examiner fails to address in claims 29 and 38:

[a] peer node broadcasting a peer discovery message on the peer-to-peer network.

The following is another example of such differences that the Examiner fails to address in claims 30, 35, 39 and 40:

[a] peer node broadcasting a peer group discovery message on the peer-to-peer network.

Other differences can readily be noted between claims 12-14, 16-18, 21 and 23-40 and claims 1-6 and 8-11. **Since the Examiner has not addressed these differences, the Examiner has not stated a proper *prima facie* rejection for claims 12-14, 16-18, 21 and 23-40.**

Applicants also assert that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejections have been shown to be

unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

**Allowable Subject Matter:**

The Examiner indicated that claims 7, 19, 20 and 22 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 an to include all limitations of the base claim and any intervening claims. In light of the above remarks, Applicants assert that claims 7, 19, 20 and 22 are in condition for allowance in their present form.

## CONCLUSION

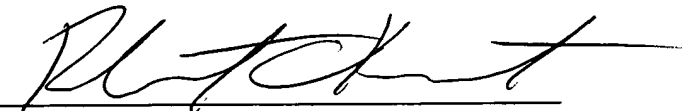
Applicants submit the application is in condition for allowance, and prompt notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5181-82104/RCK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☐ Petition for Extension of Time
- ☐ Notice of Change of Address
- ☒ Replacement Drawing Sheet for FIGs. 1A & 1B

Respectfully submitted,



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